REMARKS

This submission is in response to the Official Action dated July 22, 2004. Reconsideration of the above identified application, in view of the above amendments and the following remarks, is respectfully requested.

I. Status of the Claims

Claim 1 has been canceled without prejudice or disclaimer of the subject matter therein.

Claims 21-24 have been added.

Claims 2, 3, 6, 8-10 have been amended.

No new matter is added.

Claims 2-24 are presently pending.

Claim 1-8 and 11-15 stand rejected.

Claims 9, 10, and 16-20 are objected to.

II. Acknowledgement of Allowable Subject Matter

Applicant thanks the Examiner for the acknowledgement of allowable subject matter in claims 9, 10, and 16-20. Claims 9, 10, and 16-20 have been objected to as being dependent upon a rejected base claim. Claim 9 has been amended to be in independent form and is therefore in condition for allowance.

III. Status of the Specification

The Specification has been carefully reviewed and revised to insert the section heading "SUMMARY OF THE INVENTION."

IV. 35 U.S.C. § 102(e) Rejection

Claims 1-8 and 11-15 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0214726 to Mihara. Applicant respectfully traverses this rejection, and reconsideration is respectfully requested.

Mihara discloses a zoom lens including a first lens unit G1, a second lens unit G2, a third lens unit G3, and an aperture stop S between the second lens unit G2 and the third lens unit G3. Zooming is accomplished by moving the second lens unit G2 back and forth and by moving the third lens unit G3 and the aperture stop S to the object side (Mihara, paragraph [0287]). Mihara's second lens unit G2 includes a cemented lens with a biconcave negative lens L2₁ and a positive meniscus lens L2₂.

Claim 1 has been canceled without prejudice or disclaimer of the subject matter therein. Hence, the rejection of claim 1 has been rendered moot.

Claim 2 has been rewritten to be in independent form. Claim 2 is directed to a zoom lens including a first lens group with an overall negative refractive power, a second lens group with an overall negative refractive power, and a third lens group with an overall positive refractive power, wherein zooming is performed by moving the third lens group from an image plane side to the objection side and correction of image plane is performed by moving the second lens group. The first lens group includes a lens having a negative refractive power and a prism for changing a light path; the second lens group includes a lens having a negative refractive power; and an aperture stop is positioned between the second lens group and the third lens group.

Claim 2 states that "the first lens group consists of a lens having a negative refractive power and a prism for changing a light path arranged in said order from the object side." (Emphasis added.) The courts have previously defined the term "consisting" to exclude any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex Parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948). The claimed first lens group includes a lens having a negative refractive power and a prism for changing a light path.

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Mihara's first lens group G1 includes a negative meniscus lens L1₁, a reflective optical component R1, and a biconvex positive lens L1₂ (Mihara, paragraph [0281]). Since the first lens group of claim 2 excludes any additional elements (e.g., lenses), Mihara's zoom lens is not identical to the claimed zoom lens. Thus, Mihara does not teach or suggest all of the elements of claim 2. Claims 3-8 and 11-15 depend from claim 2 and are therefore also patentable for at least the same reasons.

Furthermore, claim 2 states that "the second lens group consists of a lens having a negative refractive power." (Emphasis added.) The claimed second lens group includes a lens having a negative refractive power. Mihara's second lens group G2 includes a biconcave negative lens L2₁ and a positive meniscus lens L2₂ (Mihara, paragraph [0284]). Since the second lens group of claim 2 excludes any additional elements (i.e., lenses), Mihara's zoom lens is not identical to the claimed zoom lens.

Applicant respectfully submits that for at least the aforementioned reasons, claims 1-8 and 11-15 of the present invention are not anticipated by Mihara. Based on the foregoing, the rejections of claims 1-8 and 11-15 under 35 U.S.C. § 102(e) should be withdrawn, and reconsideration is respectfully requested.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

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